



# UNITED STATES PATENT AND TRADEMARK OFFICE

*cl*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,655	02/25/2005	Kouichi Nakaoji	SAEG180.001APC	7988

20995 7590 11/16/2006

Knobbe Martens Olson & Bear LLP  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614

EXAMINER

CLARK, AMY LYNN

ART UNIT PAPER NUMBER

1655

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/525,655

Applicant(s)

NAKAOJI ET AL.

Examiner

Amy L. Clark

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 6-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/23/2005;10/6/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of Group I, Claims 1-6 and Applicant's election of the plant genus *Orthosiphon* in the family *Lamiaceae* in the reply filed on 24 August 2006 is acknowledged.

Claims 3 and 6-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 24 August 2006.

Claims 1-21 are currently pending.

**Claims 1, 2, 4 and 5 are under examination.**

### *Information Disclosure Statement*

The information disclosure statement (IDS) was submitted on 23 May 2005 and 6 October 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

All references with a line through the reference were not considered because Applicant did not supply the Examiner with a copy of an English translation. All references provided by Applicant that only had the abstract translated into English are indicated on the IDS, wherein the Examiner has noted, "Abstract only" next to the reference, and in these cases, the Examiner only considered the Abstract.

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "(An oral) hair growth stimulant comprising *Orthosiphon arisatus* (or *Orthosiphon*)".

### ***Claim Objections***

Claims 1, 2, 4 and 5 are objected to because of the following informalities: "Orthosiphon", "Lamiaceae", "Orthosiphon arisatus (Blume) Miq", and all other genus and species names should be italicized rather than underlined. For example, the family, genus and species names should look like this: *Orthosiphon*, *Lamiaceae*, and *Orthosiphon arisatus* (Blume) Miq. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of Claim 1 are rendered uncertain by the phrase "A hair growth stimulant for oral use" and "and extracts thereof". In the case of "A hair growth stimulant for oral use", is Applicant claiming an orally administered hair growth stimulant

Art Unit: 1655

or that the stimulant may be administered orally or both? In the case of "and extracts thereof", what type of extracts is Applicant claiming? Is Applicant claiming aqueous or organic extracts or is Applicant claiming specific active compounds? The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

The metes and bounds of Claim 2 are rendered uncertain by the phrase "wherein the plants of the genus *Orthosiphon* in the family *Lamiaceae* are cat's whiskers (*Orthosiphon aristatus* (Blume) Miq.), *Orthosiphon grandiflorus* Bold., *Orthosiphon rubicundus* Benth., *Orthosiphon spicatus* Benth. and *Orthosiphon stamineus* Benth." In Claim 2 because the claims are not consistent with the language in Claim 1, to which Claim 2 is drawn. Claim 1 is drawn to a Markush group, wherein the hair growth stimulant for oral use comprising at least one member selected from each of the families and genres listed in Claims 2, however, Claim 2 is written as though the genus and species are to be examined together. It is unclear as to whether Applicant is directing the invention to a combination of these genus and species of plants to be examined together or if these genres and species are meant to be examples of the families and genres listed in Claim 1. The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

The metes and bounds of Claim 4 and 5 are rendered uncertain by the phrase "a food for hair growth" in lines 1 and 2 of claim 4 and of claim 5 because the phrase "a food for hair growth" is unclear. What is "a food for hair growth"? What does Applicant

Art Unit: 1655

mean by this phrase? Is the food simply a nutrient source that may be applied topically or is it actually ingestible food? The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakaguchi et al. (N, JP 2001-031528 A, Translation provided herein).

Nakaguchi teaches a hair growth stimulant comprising *Orthosiphon aristatus* Bold., which may be used as a cosmetic, quasi drug or drug or may be used as a hair tonic, hair cream or hair treatment, which reads on food for hair growth.

It is noted that the reference does not teach that the composition can be used in the manner instantly claimed (for oral use), however, the intended use of the claimed composition does not patentably distinguish the composition, *per se*, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency and product-by-process claims.

Therefore, the reference anticipates the claimed subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1655

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy L. Clark  
AU 1655

Amy L. Clark  
November 8, 2006

  
**MICHELE FLOOD**  
**PRIMARY EXAMINER**